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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/749,264	12/31/2003	Ian Legate	1865-US	8491
24313	7590	11/16/2005	EXAMINER	
TERADYNE, INC 321 HARRISON AVE BOSTON, MA 02118			TO, TUAN C	
			ART UNIT	PAPER NUMBER
			3663	

DATE MAILED: 11/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/749,264	<b>Applicant(s)</b> LEGATE ET AL.	
	<b>Examiner</b> Tuan C. To	<b>Art Unit</b> 3663	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 31 December 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) 5-8 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-4, drawn to a process, classified in class 701, subclass 200.
- II. Claims 5, drawn to a program product, classified in class 369, subclass 30.04.
- III. Claims 6-8, drawn to an apparatus, classified in class 701, subclass 29.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

During a telephone conversation with Hampsch Robert on 11/01/2005, a provisional election was made with traverse to prosecute the invention of Group I, claims 1-4. Affirmation of this election must be made by applicant in replying to this Office action. Claims 5-8 have been withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

### ***Claim Objections***

Claim 3 is objected to because of the following informalities: "protocol" is misspelled. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

Claim 4 recites the limitation "the application program" in claim 1. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 1, 3, and 4 are rejected under 35 U.S.C. 102 (e) as being anticipated by Klausner et al. (US 6748305B1).

With respect to claim 1, Klausner et al. a system/method of storing data in a vehicle and evaluating said stored data. In Klausner et al, the vehicle data stored in a memory, and that said data can be acquired from a vehicle data bus (Klausner et al., abstract). The method of acquiring vehicle data is responsive to the execution of a telematics application on a local telematics unit. Such the telematics unit can be seen in figure 1 of Klausner et al., and they are units 111 through 116 connected via the data bus (108). The telematics application such as transmitting the data over data bus system is disclosed (Klausner et al., page 6, lines 39-47). Referring now to figure 3 of the patent, the claimed local vehicle library can be seen through the form of usage chip (101b), which includes a microprocessor (300) for data acquisition and analysis (Klausner et al, column 7, lines 7-11). In column 5, lines 8-23, Klausner et al. directs to the point "data going from these components to the data bus or data that can be

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retrieved from these components over the data bus", "data can be retrieved from memory 100". Therefore, Klausner et al. teach "retrieving vehicle data bus information from a database". Also, in column 7, lines 26-35, Klausner et al. teach the following: "On microprocessor (300), data or information is extracted and interpreted", and that the interpreted data is also provided for the telematics application as discussed herein above.

With regard to claim 3, Klausner et al. disclose that the vehicle information can be passed to a protocol driver, wherein such protocol driver is a CAN (Klausner et al., column 6, lines 39-41).

With regard to claim 4, Klausner et al. further teach that the telematics application includes a vehicle diagnostics application (Klausner et al, column 6, lines 39-47).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Klausner et al. (US 6748305B1) and in view of Trsar et al. (US 20050021294A1).

Klausner et al. address the limitation of claim 1 except for “establishing a wireless link to a remote server, accessing a vehicle database with the remote server, and downloading vehicle data bus information to the local vehicle library from the remote database”.

The secondary reference to Trsar et al. is directed to a diagnostics service system/method including a data processing system (100), wherein said processing system includes a communication interface (218) coupled to bus (202). Communication interface may be local area network (LAN) card, wireless links, etc (Trsar et al, paragraph 0027, lines 8-11). The communication interface (218) is provided for establishing a wireless link to the remote server (230) through the Internet (227) (Trsar et al., paragraph 0029). In addition, the communication interface (218) is sends and receives electrical, electromagnetic or optical signals. Therefore, the communication

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interface (218) associates with bus (202) to gain advantage is to either access a vehicle database (storage device 210) with the remote server, and transfers vehicle information via the bus (202) to the processing system (100) from the server (230) (Trsar et al., figure 1C; page 3, paragraph 0028).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system of Klausner et al. to include the teachings as taught by Trsar et al. to gain advantage therefore (i.e., an authorized person is able to diagnose a vehicle system of a motor vehicle by collecting vehicle information via wireless connection to the Internet. The required parts needed for a replacement may be easily found after making the connection to the Internet).

While patent drawings are not drawn to scale, relationships clearly shown in the drawings of a reference patent cannot be disregarded in determining the patentability of claims. See In re Mraz, 59 CCPA 866, 455 F.2d 1069, 173 USPQ 25 (1972).

### ***Conclusions***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tuan C To whose telephone number is (571) 272-6985. The examiner can normally be reached on from 8:00AM to 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack Keith can be reached on 571-272-6878.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Patent Examiner,

A handwritten signature in black ink, appearing to read 'Tuan C To', written over a horizontal line.

Tuan C To

November 10, 2005